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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/723,102	11/26/2003	Kazuhisa Saito	KPO10201	1302

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EXAMINER

TRINH, MINH N

ART UNIT PAPER NUMBER

3729

DATE MAILED: 10/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/723,102

Applicant(s)

SAITO ET AL.

Examiner

Minh Trinh

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 26 November 2003.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 9-14 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 9-14 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☒ Certified copies of the priority documents have been received in Application No. 09/844,226.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 7/26/04.  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.  
5) ☐ Notice of Informal Patent Application (PTO-152)  
6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

1. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed. The following title is suggested: "Method for Manufacturing an Electronic Component ".
2. The abstract of the disclosure should be revised to readable on the claimed method invention.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:  
  
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
4. Claims 10 and 14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The phrase: " the step of forming the finish plating layer is carried out . . . plating layer, " (claim 10, lines 5-6) is unclear because similar sequential order has been recited in lines 3-4 of claim 10 such as the primer-plating layer is formed prior to the forming of the finish-plating layer.

Also, "the thus formed primer plating layer" (claim 10, line 6) lacks proper antecedent basis.

The scope of claim 14 is not clear because it is not clear which one of (claims 9-13) that claim 14 is being depend on.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. Claims 9 and 11-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant Admitted prior Art (APA, Fig. 4A-4C, discussed on pages 1- 4).

APA discloses the method set forth in claim 9 of the present application comprising the steps: constructing a base member of the contact 112 made of a material which is poorly wettable to a weld brazing material (see Fig. 4), forming on said base member a finish plating layer made of a material which is highly wettable to the weld brazing material (at discussed on page 1, lines 21-22), said exposed region of said highly wettable base material serving as an arresting region for arresting creeping up of said weld brazing material (see the discussion on page 2, lines 1-5). APA does not teach forming an exposed region of said poorly wettable base member by selectively removing a portion of said highly wettable finish plating layer at said terminal section by

means of a mechanical processing technique. However, it is inherently removed a said highly wettable finish plating layer at said terminal section by means of a mechanical processing technique.

Furthermore, if argues that APA does not teach the forming on said base member a finish plating layer made of a material which is highly wettable to the weld brazing material and removing any portion of said highly wettable finish plating layer at said terminal section by means of a mechanical processing technique. It would have been an obvious matter of design choice to selectively forming on said base member a finish plating layer made of a material which is highly wettable to the weld brazing material and then removing any portion of said highly wettable finish plating layer at said terminal section by means of a mechanical processing technique since applicant has not disclosed that the process steps as described above are critical, patentably distinguishing features and it appears that the invention would perform equally well with the prior art teaching as discussed by APA's on page 3, lines 17-22).

As applied to claims 11-13, APA discloses the associated materials recited in these claims (see page 3, lines 3-5, and page 4, lines 2-6, etc.,).

As applied to claim 14, APA inherently discloses the mechanical processing technique as recited in claim 14. Furthermore, removing an unwanted portion by a means of mechanical processing technique is old and well known in the art. One ordinary having skill on the art at the time of the invention was made would know to employ a means of mechanical processing technique including at least one of

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mechanical cutting or grinding, laser beam machining , etc., in order to form a desired structure.

***Allowable Subject Matter***

7. Claim 10 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

***Conclusion***

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The prior art references cited for their teaching of electronic component manufacturing process or the like.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Minh Trinh whose telephone number is (703) 305-2887. The examiner can normally be reached on Monday -Thursday 8:00 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Vo can be reached on (703) 308-1789. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'Minh Trinh', followed by a horizontal line.

Minh Trinh 10/12/04  
Primary Examiner Group 3729

mt